Claims 3-5,7,10,21 and 22 are pending.

In view of the Declaration of Hugh MCDADE under 37 CFR 1.132, the 112 rejection has been withdrawn. However, the language "treatment of a mammal,..... susceptible to viral infection" is confusing. In view of the evidence provided and urged, amendment of "A method of treatment of AIDS ....." is suggested so that the claim is commensurate with the scope.

Claims 3-5,7,10,21 and 22 remain rejected under 35 USC 102 and 103 over EP-382,526 and/or US'407 for the reason of record.

Applicants urge that EP'526 and/or US'407 only identify a genus. Claim 10 of US'407 embraces four compounds (optical isomers) and mixtures of them. The number is sufficiently small to support a 102 rejection. In re Schaumann, 197 USPQ 5. In re Sivaramakrishnan 213 USPQ 441.

Declaration of Richard Storer dated 3/11/94 (paper no. 14) has been carefully considered. Instant compound is not a nucleoside and is significantly more different from natural nucleoside, AZT, DDI and DDC. In the declaration, applicants believe that "as a general rule the 'nonnatural' enantiomers do not possess significant antiviral activity" and that "antiviral activity and cytotoxicity went hand in hand". It is not always true. Applicant's attention is invited to Clercq article, page 122, TABLE 1, (-)carbovir is as active as (+)carbovir, but is significantly less toxic. This evidences that activity and toxicity is not always go hand in hand. To overcome a 103

rejection, the superior property urged must be unobvious or unexpected **and** not possessed by the prior art compound. The showing, Exhibit A (corresponding to Table I in applicants' July 23, 1993 response), has been considered. Toxicity has not been compared. All compounds tested are synthetic (nonnatural) and have enantiomers. It is noted there is no comparison of the racemic and enantiomers of 2-hydroxymethyl-5-(cytosin-1'-yl)-1,3-oxathiolane (the specification compares only (+) and (-) enantiomers). Showing of antiviral activity v. toxicity of racemic and enantiomers of compounds of entry 1-7 of Table I, DDI, DDC (both are approved anti-AIDS drugs) and compound of claim 10 of US'407 would be carefully considered.

In addition, the "racemic" upon administration to a recipient is capable of providing cis-4-amino-1-(2-hydroxymethyl-1,3-oxathiolan-5-yl)-(1H)-pyrimidine-2-one. The degree of purity (claims 3-5) does not render patentability.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Examiner Tsang at telephone number (703) 308-4715.

TSANG

1-5-96

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